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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD E. WALLAR, II

Appeal 2008-002714[1]
Application 09/471,429
Technology Center 2100

Decided: February 23, 2010

Before JOSEPH L. DIXON, JEAN R. HOMERE, and JAY P. LUCAS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Filed on December 23, 1999. The real party in interest is IBM Corp. (App. Br. 2.)

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1 through 7 and 10 through 29. Claims 8 and 9 have been canceled. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We reverse.

Appellant's Invention

Appellant invented a method for composing a formatted message by automatically inserting formatting tags into an unformatted message received from a user. (Spec. 3, ll. 9-20.) As depicted in Figures 2, 3, and 7, upon receiving the unformatted message including the user's selections from input text fields (62, 64, 66, 68, 70) and the desired output format (84) of the message, a message creator program (86) automatically inserts tags in the unformatted text to convert it into the formatted message as specified by the user. (Spec. 8, ll. 4-17.)

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

> 1. A method for composing a computer message, said method comprising the steps of
>
> (a) presenting a message composition area for entry of an unformatted message into at least one text field and for entry of data into at least one selection field associated with said text

field, and a message format selector for selecting an output format from a plurality of formats; and

(b) in response to entry of an unformatted message into said message composition area and selection of one of said output formats, converting said unformatted message to form a formatted message from said text field with format tags,

wherein said formatted message is formatted according to said one of said output formats, and

wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Guck	5,911,776	Jun. 15, 1999
Ferrel	6,230,173 B1	May 8, 2001
Mertama	6,629,130 B2	Sep. 30, 2003

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 1, 10, 15, 20 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Guck and Mertama.

2. Claims 2 through 7, 11 through 14, and 16 through 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination Guck, Mertama and Ferrel.

Appellant's Contentions

Appellant contends that Guck does not teach converting an unformatted message to form a formatted message with format tags, as recited in independent claim 1. (App. Br. 16-19, Reply Br. 4-6.) According to Appellant, while Guck discloses converting a source document or message having a particular format into a different format to thereby make the source document compatible with a receiving appliance, the source document is nonetheless already formatted. It is not an unformatted message, as required by the claim. (*Id.*)

Examiner's Findings

The Examiner finds that Guck's disclosure of a server converting a document with a personal format into a different format suggests that the personal format is unknown to the receiving application at the server. (Ans. 11.) Therefore, from the standpoint of the receiving application, the personal format of the document meets the ordinary meaning of an unformatted document. (*Id.*)

II. ISSUE

Has Appellant shown that the Examiner erred in finding that the combination of Guck and Mertama teaches or suggests converting an unformatted message into a formatted message, as recited in independent claim 1?

III. FINDING OF FACT

The following Finding of Fact (FF) is shown by a preponderance of the evidence.

Guck

Guck discloses an interface that allows a server to automatically convert a source file with a first format into another format that matches the requirements a receiver's appliance. (Abst.)

IV. PRINCIPLES OF LAW

Obviousness

"On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)) (citation omitted).

V. ANALYSIS

Independent claim 1 requires, in relevant part, converting an *unformatted* message into a formatted message. As set forth in the Finding of Fact section, *supra.*, Guck discloses converting the format of a source message into an equivalent second format of the message to thereby make it compliant with a receiver's appliance. We find that such conversion of the message format simply amounts to reformatting the existing format of the message. Further, we do not agree with the Examiner that the personal

format of the received message is unknown to the receiving application at the server. We find that in order for the receiving application to convert the personal format of a source document into the compliant format of the receiver's appliance, it must first identify the personal format of the source document. We also find that such identification of the personal format requires the server to have some prior knowledge or familiarity therewith. Consequently, to somehow find that Guck's conversion a document with a first format into a second format suggests or teaches converting an unformatted document into a formatted document would require us to unreasonably stretch the teachings thereof.

Additionally, we agree with Appellant that Mertama does not cure the deficiencies of Guck. (App. Br. 19-21.) Since Appellant has shown at least one error in the rejection of claim 1, we need not reach the merits of Appellant's other arguments. It follows that Appellant has shown that the Examiner erred in concluding that the combination of Guck and Mertama renders independent claim 1 unpatentable.

Because claims 2 through 7 and 10 through 29 also recite the limitations discussed above, we find that Appellant has also shown error in the Examiner's rejection of these claims for the reasons set forth in our discussion of independent claim 1. It therefore follows that Appellant has shown that the Examiner erred in concluding that the combination of Guck and Mertama renders these claims unpatentable.

VI. CONCLUSION OF LAW

Appellant has established that the Examiner erred in rejecting claims 1 through 7 and 10 through 29 as unpatentable under 35 U.S.C. § 103(a).

VII. DECISION

We reverse the Examiner's rejection of claims 1 through 7 and 10 through 29.

REVERSED

nhl

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